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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/574,909	05/19/2000	Michael J. Beaudoin	004156.P001	1410

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EXAMINER
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GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/574,909

Applicant(s)

BEAUDOIN ET AL.

Examiner

Yogesh C. Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 79-98 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 79-98 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/21/05</u>   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/21/2005 has been entered.

### ***Response to Amendment***

2. Applicant's amendment received on 1/21/2005 is acknowledged and entered. Claims 1-78 are cancelled and new claims 79-98 have been added. Currently claims 79-98 are pending for examination.

### ***Response to Arguments***

3. Applicant's arguments with respect to new claims 79-95 have been considered but are moot in view of the new ground(s) of rejection necessitated due to submission of new claims 79-98.

### **35 USC 101 Rejection**

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 79-92 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(A) whether the invention is within the technological arts; and

(B) whether the invention produces a useful, concrete, and tangible result.

**A. Technological Arts Analysis**

In the present case claims do not satisfy the "Technological Arts" requirement.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Moreover, the courts have found that a claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer. See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). Finally, the Board of Patent Appeals and Interferences (BPAI) has recently affirmed a §101 rejection finding the claimed invention to be non-statutory based on a lack of technology. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

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In the present case, body of the claims 79-92, that is the manipulative steps, such as creating a database, receiving information, providing first list, receiving a selection of task, selecting home service providers, providing a third list do not recite application/involvement/use or advancement of technological arts but could be performed manually. A database could be created in a notebook and similarly other steps could be performed manually. Though the preamble recites intended use of a computer-implemented method, it has not been given patentable weight because A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Therefore, the claims are directed towards non-statutory subject matter. To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify which of the steps are being performed within the technological arts, such as incorporating/integrating a computer/software/hardware computer network or electronic network functionally with manipulative steps recited in the claims.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 79-81, 83, 85-88, 90, and 92-98 are rejected under 35 U.S.C. 102(e) as being anticipated by Giovannoli (see US Patent 5,758,328).

Regarding claim 79, Giovannoli teaches a computer-implemented method for matching a consumer with a home service provider, (see at least col.2, lines 52-64, wherein the vendors providing services correspond to home service providers) comprising:

creating a database comprising home service providers, see at least col.2, lines 52-60, which discloses a computerized system having a CPU and **Storage means** storing the information about the network members, which includes service providers. See col.4, lines 1-49, which discloses that this information includes data about registered home service providers, such as description of services being supplied and a software presenting this information about different services to be provided by different service providers in the form of preprogrammed menu ( corresponds to providing a list comprising tasks that relate to skills of service providers in response to receiving information from the service providers.) The services and registered suppliers of services in Giovannoli correspond to home services and home service providers. Col.8, lines 13-20 discloses that the centralized computer system of Giovannoli filters the service providers based upon their stored data relating to their likelihood of

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accepting /responding to the request for quotation/that is selection of a task by a user which reads upon the claimed limitation of creating data for tracking a historical acceptance of consumer leads by each home service provider. Note: Consumer leads correspond to the requests for quotations in Giovannoli. Also see col.5, lines 25-32 which teaches prioritizing the vendors, that is home service providers according to a formula, such as the service the providers would like to choose and this implies that data relating to historical acceptance of tasks/requests for quotations by particular vendors is stored because then only it is possible to filter out such vendors from a list of registered vendors.

Giovannoli discloses receiving a selection of task from the first list, in response to receiving the selection of the task, forming a second list comprising home service providers from the database who match the selected task, selecting home service providers from the second list based upon historical acceptance of consumer leads by home service providers and providing a third list comprising home service providers (see at least Fig.5 which shows receiving a selection of task in the form of RFQ from the menu, as analyzed above. After receiving this RFQ the central computer system, in Giovannoli, creates a table containing vendors that will be selected for this RFQ/selected task from the first list and then these selected service providers are further subjected to filtering to obtain qualified vendors list, which corresponds to a third list, as claimed based upon the historical acceptance data, such as type of currency, geographical region, etc. and the RFQ, that is the selected task is presented to this third list of service providers. See also col.5, lines 9-36.

Regarding claim 80, Giovannoli teaches selecting home service providers who match a geographical location (see at least col.5, lines 9-13 which discloses selecting vendor based upon vendor location. See also, col.5, lines 55-57).

Regarding claim 81, Giovannoli discloses prioritizing providers of the second list based on the historical acceptance of consumer leads by service providers( see at least col.25-36 which teaches " prioritizing the vendors based upon a formula and this formula could be on the basis of condition set by service providers, which refers to a stored data or historical data and a basis of accepting the consumer lead/RFQ.)

Regarding claim 83, Giovannoli discloses receiving background information from home service providers (See at least col.4, lines 1-12, which discloses receiving information from vendors while registering them and also information about the services/products that they want to supply, plus their preferences, see col.5, lines 9-36).

Regarding claim 85, Giovannoli discloses sending a message that identifies a consumer to home service provider present in the third list (see at least col.5, line 58-65 which disclosing sending a response from a service provider via e-mail to the buyer in response to his RFQ/selection of a task which is required by the buyer.



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Regarding claims 86-88, 90, and 92, their limitations are closely parallel to the limitations of claims 79-81, 83 and 85 and are therefore, analyzed and rejected on the same basis.

Regarding system claims 93-98, their functional limitations are closely parallel to the limitations of claims 79-81, 83 and 85 and are therefore, analyzed and rejected on the same basis. As regards structural limitations, such as server, client's computer/browser and communication via Internet, please see at least col.4, line 50-col.5, line 8).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 82, 84, 89 and 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giovannoli and further in view of the Improvenet periodicals cited in the previous office action: "Improvenet matches homeowners, contractor" Bill Rumbler, Chicago Sun -Times, May 2, 1999, page 3. (PTO-89% Ref U), "Way to find contractor just improved greatly, " Joseph Szadkowski, Washington Times, Washington, March 1, 1999, page E3. (PTO-892, Ref V), Homeowners find contractors on the Internet," Beth Belton, USA Today, Arlington, April 13, 1999, page 02B. (PTO-892, Ref W), [www...//web.archive.org/web/19961126000000/www.Improvenet.com](http://www.web.archive.org/web/19961126000000/www.Improvenet.com) [Internet archiving program], retrieved on November 3, 2002 <Internet> Dec. 21 1996 - November 26, 2002. (PTO-89% Ref X); hereinafter referred to as Improvenet.

Regarding claim 82, Giovannoli teaches a computer-implemented method for matching a consumer with a home service provider as analyzed in claim 79 above. Giavannoli does not disclose selecting service providers based upon past response times. However, in the same field of endeavor, Improvenet suggests selecting service providers based upon past response time (see Improvenet Ref: U, paragraph 5, page 2, " After you login.....you are asked about your project.....**when you want to get started.....**"). The fact that consumers are asked about the information that is when they want to start their project implies that while selecting the service providers this criteria will be used which reflects the past response time by the service providers.

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Because if the consumer wants to start their work at the earliest then service providers with fast past response time will be selected and if the consumer is not in hurry to start their project then service providers with longer response times can also be considered.

Regarding claim 84, Giovannoli teaches a computer-implemented method for matching a consumer with a home service provider as analyzed in claim 79 above. Giovannoli in view of Improvenet also discloses storing information about tasks performed by a home service provider, see Giovannoli col.4, lines 1-12, lines and col.5, lines 9-36, about geographic region, see analysis of claim 80 above, service response and fulfillment time, see analysis of claim 82 above, communication preferences, see Giovannoli, col.5, line 62-col.6, line 11, and preference of tasks, see Giovannoli col.4, lines 1-12, lines and col.5, lines 9-36.

Regarding claims 89 and 91, their limitations are closely parallel to the limitations of claims 82 and 84 and are therefore, analyzed and rejected on the same basis.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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US Patent 6,868,389 to Wilkins et al. discloses creating a profile database 32 which includes a list of prospect identifiers, that is consumer leads and their identifiers, and transferring them to service providers (see at least Abstract).

Business Editors; " Improvenet Launches Contractor Watch: A Free, Nationwide Contractor Quality Tracking Network For Homeowners"; Business Wire; New York; Sep 2, 1998; pg.1; extracted from proquest database on 7/18/2005 teaches creating a database of information related to contractors in the field of home improvement services wherein it is possible to track information on the qualification of service providers and their past performances.


WO 98/49642 to Grim et al. discloses an automated marketing system for telemarketing services, wherein a database of clients profiles is created to provide potential leads to telemarketers (see at least abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
July 18, 2005